

The Examiner has taken the position that when the applicant says he has lubricated a surface he hasn't obtained a lubricated surface, but only described a method of lubrication. Applicant requests the Examiner to explain how conducting the process of lubricating a surface does not result in obtaining a lubricated surface.

The written description clearly shows applicant had possession of the invention now claimed as page 20, inter alia, makes clear. This describes the invention as comprising a lubricant composition of matter comprising a superabsorbent polymer combined with a material for decreasing friction between moving surfaces, which is a lubricant both generally and specifically described in the written description. Page 20 also describes the invention as comprising a method of lubricating a surface comprising coating the surface with a lubrication composition comprising a superabsorbent polymer combined with the material for decreasing friction between moving surfaces.

Pages 6-19 of the written description describe these various lubricants which include petroleum lubricants (and lubricant additives), synthetic lubricants, greases, solid lubricants and metal working lubricants. This part of the written description also states that these lubricants are used on cables (page 12, penultimate paragraph) and wire (page 16, second full paragraph and page 17, first paragraph) as well as in automobile engines, high speed machinery, high pressure hydraulic systems, torque convertors, aircraft engines, turbine engines, steam engines, steam turbines, electric motors, hydraulic systems, die casting machines, furnace controls, electric welders, navy hydraulic catapults, electric transformers, refrigerator compressors, die lubricants, metal working molds, oxygen equipment, airframe lubrication, nuts, bolts, screws and gears. These comprise only some of the substrates coated with applicant's lubricant composition.

In specifically rejecting the claims, the Examiner did not find "any explicit disclosure for claim 61 'the substrate comprises a cable. . . .'" (July 27 Office Action, page 3.) Applicant's disclosure, however, supports claim 61. The invention comprises applying the claimed lubricant composition to a substrate as well as the article of manufacture obtained. Page 20 of the written description states that applicant's lubricant composition comprises a superabsorbent polymer in combination with lubricants described in the written description, which include those described at pages 6-19. The lubricants described at page 12 in this regard are used in cables (written description, page 12, line 6 from the bottom). The application therefore supports claim 61 directed to the lubricant of the invention on a substrate where the substrate comprises a cable.

The Examiner also did not find any explicit disclosure "for 'claim 62 [where] the substrate comprises a wire.'" (July 27 Office Action, page 3). The written description describes a coating comprising a superabsorbent polymer further comprising a lubricant applied to a wire substrate at page 16, line 8 from the bottom, page 17, line 5 and page 47, line 8 from the bottom.

The Examiner also did not find any explicit disclosure for the claim 58 parameter wherein the superabsorbent polymer absorbs greater than 100 times its weight in water. The written description at page 22, line 2 from the bottom discloses this parameter as does claim 2 as originally filed.

The Examiner also did not find any explicit disclosure for the claim 58 parameter that the superabsorbent polymer desorbs water when the coating is dried. The written description page 31, first and second full paragraphs and penultimate paragraph, and the paragraph bridging pages 31 and 32 support this aspect of claim 58.

Pages 31 and 32 in this regard describe a method of combining the superabsorbent polymer with the lubricant and additives, when employed, by using water or high humidity (80% R. H.) to swell the superabsorbent followed by placing the composition obtained in a 27-38% R. H. environment to remove substantially all of the water introduced in the first part of the process. The superabsorbent polymer clearly desorbs water upon drying.

The Examiner rejects claims 57-68 under 35 U.S.C. §112, first paragraph, as allegedly containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly concerned to make and/or use the invention. Application traverses the rejection and requests further consideration and reexamination.

The Examiner argues that the written description does not enable claim 57 and its dependent claims relative to forming a coating on the surface of a substrate where the coating comprises a superabsorbent polymer further comprising a lubricant.

Applicant incorporates by reference the previous response to the 35 U.S.C. §112, first paragraph rejection showing applicant had possession of the claimed invention at the time of filing the instant application relative to not only the coating formed on the surface of a substrate (claim 57), but also the superabsorbent polymer that absorbs greater than 100 times its weight in water and desorbs water when the coating is dried (claim 58), the coated cable (claim 61), and the substrate comprising a wire (claim 62).

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Conclusions

Applicant respectfully requests the Examiner to withdraw the rejections under 35 U.S.C. §112 in view of the specific support for the various claimed elements that the written description contains. If filing this response requires an extension of time pursuant to 37 C.F.R. §1.136 and payment of an extension of time fee or other fee, any of which this response fails to account for, applicant's attorneys request such an extension and payment of any fees due from their Deposit Account No. 06-0916.

Respectfully submitted,

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